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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,967	01/15/2002	Kevan M. Shokat	051538-5001-01	3019
9629	7590	11/03/2003	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			WEBER, JON P	
			ART UNIT	PAPER NUMBER

1651

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/044,967	SHOKAT, KEVAN M.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jon P Weber, Ph.D.	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 May 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 61-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-6 and 61-76 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

***Status of the Claims***

Claims 1-6 and 61-76 have been presented for examination following the copy of marked up claims in the letter of 29 May 2002.

The letter of 15 January 2002 contained: a preliminary amendment canceling some but not the same claims as the letter of 29 May 2002; a substitute specification; a marked up version of the specification to be substituted; a request to amend the figures; and a Privileged & Confidential communication to Allen Hakimi from Bonnie McLcod and Erich Veitenheimer dated 23 May 2002 re Human tau transgenic mice. The latter is mentioned because it is unusual as well as apparently not belonging to this application.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, drawn to an inhibitor of mutant but not wild-type enzyme with identical function and method of inhibition with the same, unclassifiable due to lack of disclosure of such agents and lack of specificity to compounds or enzyme.
- II. Claims 4-6, drawn to an inhibitor that inhibits cell growth in a cell containing a mutant but not a wild-type enzyme and method of inhibition with the same, unclassifiable due to lack of disclosure of such agents and lack of specificity to compounds or enzyme.
- III. Claims 61-73, drawn to a protein kinase inhibitor and a methods of use thereof, classified in class 514, subclass 46, and class 435, subclass 194, for example.

- IV. Claims 74-76, drawn to an inhibitor of mutant but not wild-type protein kinase with identical function and method of inhibition with the same, unclassifiable due to lack of specifying such agents and lack of specificity to kinase.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions Group I and II broadly encompass all enzymes, Groups III and IV encompass only protein kinases, albeit broadly. There is no reason why the inhibitors of Group I must be the same as those of Group II, and similarly between Groups III and IV. Group III is drawn to inhibitors with a specific structure, whereas Groups I, III and IV are drawn to inhibitors without specific structure. It is not understood how an inhibitor for Groups I, II and IV could be specific for a mutant enzyme over the wild-type if both enzymes are functionally identical. A difference in inhibition properties would be a function for which they are non-identical. Hence the limitation is inherently impossible.

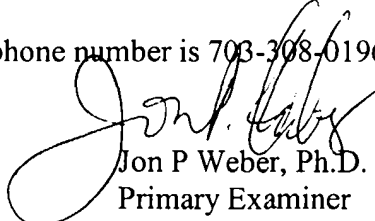
Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, III or IV, for example, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon P Weber, Ph.D. whose telephone number is 703-308-4015. The examiner can normally be reached on daily, off 1st Fri, 9/5/4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 703-308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Jon P Weber, Ph.D.  
Primary Examiner  
Art Unit 1651

JPW  
30 October 2003